

### **REMARKS**

This responds to the Office Action mailed on January 3, 2007.

Claims 1, 3, 6, 9, 17, 26, 28, 30 and 37 are amended, claim 10 is canceled, and no claims are added; as a result, claims 1-9 and 11-43 remain pending in this application. Claim 1 has been amended to clarify the operation of a service provider. The amendments to claims 3, 6, 17, 26, 28, 30 and 37 correct minor typographical errors and are not in response to an art based rejection or other reason related to patentability.

#### **Drawing Objections**

Fig. 3 of the drawings was objected to as failing to comply with 37 C.F.R. 1.84(p)(4) because reference characters “322” and “324” have both been used to designate “Service Description”. Submitted with this response are replacement drawings in which Figure 3 has been amended such that “Service Description” consistently uses reference characters “324”. In view of the amendment to the drawings, Applicant respectfully requests removal of the objection.

#### **Abstract Objection**

The Abstract of the disclosure was objected to because on page 24, line 13, HTTP appears as “HITP”. Applicant has amended the Abstract as indicated above to correct the typographical error. Applicant respectfully requests removal of the objection to the Abstract.

#### **Disclosure Objections**

The disclosure was objected to because of various informalities. Applicant has amended the specification as suggested to address the informalities noted in the Office Action. Applicant respectfully requests removal of the objection to the specification.

Applicant notes that the Office Action requested correction of the phrase “coin in” appearing at page 10, line 15. Applicant respectfully submits that the term “coin in” is known to those of skill in the art as the monetary value received from players from any of a variety of sources such as coins, tokens, bills, electronic funds transfer, credit/debit cards, tickets etc. for

wagering on a wagering game machine. Thus correction related to the phrase "coin in" is not believed to be required.

#### Claim Objections

Claim 7 and 10 were objected to as being substantially duplicates of each other. Claim 10 has been canceled in this response.

Claims 3, 6, 17, 26, 28, 30 and 37 were objected to for informalities. Claims 3, 6, 17, 26, 28, 30 and 37 have been amended as suggested in the Office Action.

#### Double Patenting Rejection

Claims 30-31 and 37-38 were provisionally rejected under a non-statutory double patenting rejection, specifically claims 1-2 and 25-26 of U.S. Patent Application Serial No. 10/788,661 in view of Gatto (U.S. 6,916,247).

Claims 30-35 and 37-42 were provisionally rejected under a non-statutory double patenting rejection, specifically claims 1-7 of U.S. Patent Application Serial Nos. 10/802,699, 10/802,537, 10/813,653, 10/857,433 and 11/068,065 in view of Gatto (U.S. 6,916,247).

Applicant does not admit that the claims are obvious in view of the cited patent applications and art. However, Applicant will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) to obviate these rejections when all other issues related to the patentability of the claims has been resolved.

#### §101 Rejection of the Claims

Claims 30-43 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action states that "while 'processing requests' may be transformative, the invention as claimed does not produce a useful, concrete, and tangible result." Applicant respectfully traverses the rejection. Producing a transformation inherently produces a concrete and tangible result. Further, publishing the availability of a service is clearly useful to the systems and machines that desire to utilize the service. Moreover, claims 30 and 37 recite "processing one or more service requests between the gaming machine and the service." Such processing is useful, concrete and tangible. Processing a service request is clearly useful to the

machine making the request. Further, processing a request is concrete and tangible. The processing of a request requires transformations in the service provider and/or the requesting machine as part of the processing of the request. Such transformations result in tangible changes in the client and server. Further, the results of processing the request is repeatable, thus making the claim concrete and tangible. In view of the above, Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 30-43.

### §102 Rejection of the Claims

Claims 1-14, 16, 18, 21-35 and 37-42 were rejected under 35 U.S.C. § 102(e) for anticipation by Gatto (U.S. 6,916,247). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that a *prima facie* case of anticipation does not exist because the claims contain elements not found in Gatto.

For example, claim 1 as amended recites “at least one service provider communicably coupled to the gaming network, said service provider operable to publish the availability of a service, receive registrations from gaming machines for the service, and perform the service.” Similarly, claims 30 and 37 as amended recite “publishing an availability of the service on the gaming network with a discovery agent communicably coupled to the gaming network” and further recite “registering by the gaming machine with the service.” The Office Action states that Gatto, at column 15, lines 54-56, in Figure 20, and at column 14, lines 18-20 teaches the recited language. Applicant respectfully disagrees with this interpretation of Gatto. Applicant notes that the process described in Gatto is in fact opposite to the method of Applicant's claims. In Gatto, the specialized device broadcasts its availability and a service registers with the device, specifying the events the service is interested in (see Gatto at column 14, lines 17-20). This is in

contrast to Applicant's claims 1, 30 and 37, where the service publishes its availability and clients can discover and register with the service to then send events to the service. In other words, in Gatto, it is the service that registers with devices, rather than clients registering with a service as recited in Applicant's claims. As a result, Gatto does not teach or suggest each and every element of Applicant's claims 1, 30 and 37. Therefore Gatto does not anticipate claims 1, 30 and 37. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 30 and 37.

Claims 2-14, 16, 18, and 21-29 depend either directly or indirectly from claim 1. Claims 31-35 depend either directly or indirectly from claim 30. Claims 38-42 depend either directly or indirectly from claim 37. These dependent claims inherit the elements of their respective base claims and are therefore not anticipated for at least the reasons discussed above regarding their respective base claims.

Further, claim 9 as amended recites an authorization service "operable to determine authorization to use services on the gaming network." Applicant notes that the authorization described in Gatto at column 8, lines 39-40 is a payment authorization, not authorization related to authorizing use of services on a gaming network. Therefore Gatto does not disclose each and every element of claim 9. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 9.

Additionally, claim 16 recites a mobile gaming device location service. The Office Action asserts that Gatto, at column 2, lines 53-54 discloses the recited language, stating "if the gaming device is mobile, the location needs to be determined in order for the network to communicate with it." Applicant respectfully disagrees with this interpretation of Gatto. First, the cited section of Gatto merely states that a gaming device may be "portable and/or mobile." Nothing in the cited section of Gatto, nor in Gatto as a whole discloses determining a location for a mobile gaming device. Further, all that is required to be for a mobile gaming device to communicate over a wireless network is for the device to be within the signal range of a wireless access point. While multiple signal strengths for multiple access points may be used to assist in the location of a mobile gaming device, contrary to the statement in the Office Action there is no requirement that the location of the access point or the mobile device needs to be known to the network or any server on the network in order for a mobile gaming device to communicate with

a wireless access point. As a result, it is not inherent that being within a signal range provides a location of the mobile gaming device. Therefore Gatto does not disclose a mobile gaming device location service. As a result, Gatto does not anticipate claim 16. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 16.

Moreover, claim 25 recites a property management service. The Office Action states that Gatto, at column 19, lines 8-11 discloses a property management service. As described in the specification at page 10, lines 29-33, a property management service provides integration services with a property's hotel or restaurant reservation systems. The cited section of Gatto merely states that a wireless or mobile gaming device may be taken to various locations on a property. No services related to transporting the device are described, and Gatto does not disclose interacting with other property services such as reservation systems. As a result, Gatto does not disclose providing a property management service. Thus Gatto does not disclose each and every element of claim 25, and does not anticipate claim 25. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 25.

### §103 Rejection of the Claims

Claim 15 and 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto in view of Murata (U.S. Publication No. 2002/0013174). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection because claims 15, 19 and 20 contain elements not found in the combination of Gatto and Murata.

Applicant notes that claims 15, 19 and 20 depend from claim 1, which recites elements related to a service that publishes its availability and where clients can discover and register with

the service to then send events to the service. As discussed above, Gatto fails to teach or suggest such a service. Applicant has reviewed Murata and can find no teaching or suggestion of such a service. As a result, the combination of Gatto and Murata fails to teach or suggest each and every element of claims 15, 19 and 20, including elements inherited through base claim 1. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 15, 19 and 20.

Further, claim 15 recites that the service is a progressive service. The Office Action correctly states that Gatto does not teach a progressive service. However, the Office Action attempts to make up for the deficiency in Gatto by asserting that Murata, at paragraph 58, lines 4-7 and paragraph 60, lines 7-11 teaches the recited language. Applicant respectfully disagrees with this interpretation of Murata. First, Murata does not disclose a progressive service as the term is known in the art. In a wagering game system, a progressive wagering game is one in which a portion of each wager that is made on participating wagering game machines is placed in a pool that is available for players on the participating wagering game machines to win upon a particular outcome on a participating wagering game machine. Murata merely discloses that points or prizes may be progressively increased. Murata does not disclose a progressive in which multiple wagering game machines place a portion of each wager in a pool. Second, Murata does not disclose that the progressive feature is provided by a service on a gaming network. Murata merely discloses that a particular game may provide for progressively increasing points or prizes. In view of the above, Murata does not teach or suggest each and every element of claim 15. As a result, the combination of Gatto and Murata fails to teach or suggest each and every element of claim 15. Therefore claim 15 is not obvious in view of the combination of Gatto and Murata. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 15.

Claim 19 recites that the service is a game theme location service. The Office Action correctly states that Gatto does not disclose the recited language. However, the Office Action goes on to state that Murata, at paragraph 25, lines 11-16 and at paragraph 55, lines 4-10 discloses a game theme location service. Applicant respectfully disagrees with this interpretation of Murata. Paragraph 25 makes no mention whatsoever of themes or anything that can be equated to a theme. Paragraph 55 of Murata provides examples of themes for a game web site. However, Murata does not teach or suggest a service that may be used to provide the location for

a wagering game machine having a particular theme. Thus the combination of Gatto and Murata fails to teach or suggest each and every element of Applicant's claim 19. Therefore claim 19 is not obvious in view of the combination of Gatto and Murata. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 19.

Claims 17, 36 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto in view of Barnes (U.S. Publication No. 2004/0065805). Applicant respectfully traverses the rejection, because claims 17, 36 and 43 recite elements not found in the combination of Gatto and Barnes.

Applicant notes that claims 17, 36 and 43 depend from claims 1, 30 and 37 respectively. Each of base claims 1, 30 and 37 recites elements related to a service that publishes its availability and where clients can discover and register with the service to then send events to the service. As discussed above, Gatto fails to teach or suggest such a service. Applicant has reviewed Barnes and can find no teaching or suggestion of such a service. As a result, the combination of Gatto and Barnes fails to teach or suggest each and every element of claims 17, 36 and 43, including elements inherited through base claims 1, 30 and 37. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 17, 36 and 43.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or

affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date April 9, 2007

By 

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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9<sup>th</sup> day of April 2007.

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